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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/839,495

04/23/2001

Kiyoshi Matsutani

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EXAMINER

BORLINGHAUS, JASON M

ART UNIT

PAPER NUMBER

3693

MAIL DATE

DELIVERY MODE

09/01/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 09/839,495</p>	<p>Applicant(s) MATSUTANI, KIYOSHI</p>	
	<p>Examiner JASON M. BORLINGHAUS</p>	<p>Art Unit 3693</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 July 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-15.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Jason M Borlinghaus/
Examiner, Art Unit 3693

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that the asserted prior art (Mockett and Gopinathan) fail to disclose or suggest an "apparatus" and all its attendant limitations. Applicant puts special emphasis on the term "apparatus" but Examiner is uncertain as to its significance, as the prior art discloses systems composed of physical devices (apparatuses) and suggests apparatus embodiments to perform the disclosed methods.

Applicant argues that the cited prior art fail to disclose "an apparatus" that performs the claimed functions. Examiner has repeatedly mapped portions of the cited prior art to the claim limitations and has gone to great lengths to respond to the Applicant's previous arguments. Does Applicant believe that the claimed subcomponent units (e.g. communication unit, processing unit, output unit) and the functions claimed are not present in the art? Or, based upon the wording of the Applicant's arguments, is the Applicant arguing that although the subcomponent units and functions are present in the prior art, that they are being disclosed as a system or a method, rather than an "apparatus"?

Based upon the length at which the examiner and Applicant have discussed this issue, Examiner is forced to conclude that Applicant is arguing the second issue - that the disclosed subcomponents and functions are not disclosed as being part of "an apparatus" specifically. Examiner refutes that as the prior art discloses systems composed of physical devices (apparatuses) and suggests apparatus embodiments to perform the disclosed methods. And even if such an assertion was true, it would have certainly been obvious to embody a system or method via an apparatus.

Applicant specifically argues that the prior art (Gopinathan) does not teach or suggest "communicating with both the server of a credit card firm and a server owned by a settling financial institution". However the secondary reference (Mockett) does disclose this feature as Mockett discloses communicating with a credit card server and a settling financial institution (automated clearing house or merchant bank). (see fig. 1; para. 17).

Applicant asserts that "Examiner does not distinguish among credit cards, bank ATM cards and the telephone calling cards." Examiner asserts that the primary reference (Gopinathan) while discussing other types of payment cards, such as bank ATM cards and telephone calling cards, does disclose that the "techniques and principles discussed herein apply to other types of customer accounts, such as charge cards, bank automated teller machine cards and telephone calling cards." (see col. 1, lines 21 - 26). The secondary reference (Mockett) is directed toward credit cards. (see abstract). While the references disclose and discuss other payment cards, such does not disqualify them or make them any less applicable as prior art pertaining to the claimed invention.

Applicant recounts portions of the specification to illustrate the differences between the Applicant's invention and the prior art. However, although the argued elements may be found as examples and/or embodiments in the specification, they were not claimed explicitly in the disputed claim(s). Nor was the terminology used in the disputed claim(s) defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms. Therefore, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. In re Van Geuns, 988 F.2d 1181 (Fed. Cir. 1993) and MPEP §2111.01.

Applicant argues that the prior art does not disclose "taste information extracting means for extracting taste information of a user based upon shop use historical information, facilities use historical information or shopping historical information, which are contained in the credit card charge historical information." Gopinathan discloses the storage of shopping historical information (transactional patterns for the customer). Such information can consist of numerous variables, such as merchant category code or merchant ZIP code. Such information is taste information as it denotes the user's preferences and patterns. Such taste information is extracted or retrieved from a database by an information extraction means. (see col. 26, line 64 - col. 27, line 15; col. 27, line 64 - col. 24).